UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/684,057	10/06/2000	Stefan Johansson	15292.2	1607

7590   11/29/2005

Attn: DANA L. TANGREN
WORKMAN, NYDEGGER & SEELEY
1000 EAGLE GATE TOWER
60 EAST SOUTH TEMPLE
SALT LAKE CITY, UT 84111

EXAMINER
REILLY, SEAN M

ART UNIT	PAPER NUMBER
2153	

DATE MAILED: 11/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

		Application No.	Applicant(s)
Office Action Summary		09/684,057	JOHANSSON, STEFAN
		Examiner	Art Unit	
		Sean Reilly	2153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>26 September 2005</u>.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-30,35 and 36</u> is/are pending in the application.

  4a) Of the above claim(s) <u>31-34</u> is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-30,35 and 36</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

  Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

  a)☐ All b)☐ Some * c)☐ None of:

    1.☐ Certified copies of the priority documents have been received.

    2.☐ Certified copies of the priority documents have been received in Application No. _____.

    3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

  * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>9/26/05</u>.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Another Examiner has been assigned to this application.

This Office action is in response to Applicant's amendments and request for

reconsideration filed on September 26, 2005. Claims 1-30 and 35-36 are presented for further

examination. Claims 31-34 have been withdrawn from consideration as being directed toward

the non-elected invention.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 9/26/05 is in compliance with the

provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being

considered by the examiner.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

1.   Claims 1-30 and 35-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Winbladh (U.S. Patent No. 6,205,330), in view of Lager et al. (U.S. Patent No. 6,636,502,

hereinafter "Lager").

In considering claims 1, 5, 20, 26, 29, 35, and 36 Winbladh discloses a method for

initiating immediate transfer of packet data from a network server ("server 11") to a mobile

communication station ("MS unit 20" coupled to "PC 22") over a digital radio communication

network ("GSM" network, col. 7, lines 3-8; col. 3, lines 50-52), including the acts of:

Sending a message to the mobile communication station using a message service

provided by the digital radio communication network ("SMS [message] is sent to the MS unit 20,

"col. 7, lines 6-8), said message including a first data network address of said network server

(col. 7, lines 7-8, 32-35, "SMS message is comprised of... a field 'DSG address (Data SMS

Gateway Address)' containing the address and/or telephone number of the server 11 in which the

intended e-mail has been stored");

Extracting the first data network address from the message by way of an application

executing on the mobile communication station (col. 7, lines 58-61, "the communications

software 46 reads the agent-part 48 of SMS and... calls the number in the 'DSG address,'"

wherein the "DSG" address is the address of the server, col. 7, lines 31-35); and

Establishing, by the application of the mobile communication station having a second

data network address (the computer unit 22 necessarily has a second data network address to set

up the session), a data protocol session between said mobile communication station and said

network server using said first data network address (col. 7, lines 61-62, "calls the number in the

'DSG address' 47 (start of a session)");

Whereby the network server is able to transfer data to the mobile communication station

and the application using said data protocol session (col. 7, lines 63-67, "[server 11] commences

the transmission of data in the same session").

However, Winbladh failed to specifically recite the digital radio communication network

utilizes *packet*-based communication. Winbladh's uses a GSM network for communication that

is not necessarily packet based ("GSM" network, col. 7, lines 3-8; col. 3, lines 50-52).

Nonetheless, Winbladh disclosed that his system is not restricted to any specific wireless

telephone system such as GSM and that other telecommunications systems can be used within

the system (Col 3, lines 38-48). Thus, one of ordinary skill in the art would have been motivated

to seek out and use other known wireless telephone systems within Winbladh's system. One

widely known wireless telephone system that utilizes packet-based communication is GPRS.

The use of GPRS in the wireless telephone environment was widely known in the art at the time

of invention, as evidenced by at least by Lager and Applicant's admitted prior art (Specification

pg 1). Further the inclusion of a GPRS system, including a GPRS attach within a GSM network

was well known, as evidenced by Lager. In a similar art, Lager discloses a GSM system that

allows a mobile device to set up a packet based session with a network service (Col 1, lines 17-

22), including a means for allowing the mobile device to attach to the network, wherein the

system uses a GPRS attach (col. 3, lines 41-56; col. 7, line 64 – col. 8, line 30). Given this

knowledge, a person having ordinary skill in the art would have readily recognized the

desirability and advantages of incorporating the GPRS into the GSM system taught by Winbladh,

because GPRS provides more effective use of scarce resources (see Lager, col. 1, lines 22-26).

Therefore, it would have been obvious to incorporate the GPRS into the GSM system taught by

Winbladh.

In considering claim 2, Winbladh further discloses that the message service is SMS ("SMS," col. 7, line 7).

In considering claim 3, Winbladh further discloses that the first packet data network address is an IP address (col. 7, lines 4-5, 61-62, wherein the server is an "Internet GSM Smart Access Server" and thus uses an IP address).

In considering claim 4, Winbladh further discloses that the application performs the act of identifying the mobile communication station to the packet data service part of the digital radio communication network, if the mobile communication station is not identified to that service (col. 8, lines 23-33, wherein upon start-up at the beginning of a session, the mobile station software sends the its number and a password to the server).

In considering claims 6, 21, and 30, Winbladh discloses the claimed activation step of sending a request from the application to the network to activate a packet data service for the mobile communication station if the station does not have such a packet data service activated (col. 8, lines 23-34). However, Winbladh does not disclose the claimed steps of allocating a temporary network address as part of the activation step to the mobile communication station, wherein the temporary network address becomes the address used by the station for the station. That is because Winbladh remains silent regarding how the address is allocated to the mobile communication station. Nonetheless, the GPRS system taught by Lager actually uses a temporary address assignment scheme. See Lager, col. 3, lines 46-57; col. 8, lines 6-30. It is

advantageous to use temporary addresses for mobile devices in a GSM network, because

temporary addressing allows for a larger number of systems to connect to the network.

Therefore, it would have been obvious to use the temporary address assignment scheme taught

by Lager to improve the scalability of the system taught by Winbladh.

In considering claims 7 and 22, Lager further teaches using GPRS Packet Data Protocol

Context activation as the activation request (col. 3, lines 58-65; col. 6, lines 30-35; col. 8, lines 6-

20).

In considering claims 8 and 23, Lager further discloses that the temporary network

address is an IP address (col. 8, lines 6-20).

In considering claim 9, Winbladh further discloses that the application performs:

Examining an activation code present in the message received by the mobile

communication station (col. 8, lines 55-56, "activation code [is] sent from the server 11 via an

SMS"); and

Performing said act of identifying the mobile communication station to the radio

communication network only if an appropriate activation was found in the message during the

examining act (col. 8, lines 62-65, "manual insertion of the obtained code via the activation

window activates the communications software 46 for the possibility of sending and receiving e-

mail," or col. 9, lines 1-3, wherein activation is automatic).

In considering claim 10, Winbladh further discloses that the application performs:

Examining a service indication field ("field 'Code' 43," col. 7, lines 29-30); and

Presenting a message to a user of the mobile communication station the message being

based on the content of the service indication field and describing the service that will be

initiated (col. 8, line 62 – col. 9, line 8, wherein a "PIN code" is additionally entered by the

mobile user to activate the service).

In considering claim 11, Winbladh further discloses that the message is a text message

(col. 8, lines 54-55).

In considering claim 12, Winbladh further discloses that the application further performs

the acts of:

Waiting for a reply to the presented message from the user of the mobile communication

station (col. 8, lines 54-55, waiting for the user to enter the code); and

Continuing with, or aborting, said act of identifying the mobile communication station to

the digital radio communication network in dependence on the reply to the presented message

(col. 8, lines 56-57, wherein registration is confirmed if the correct code is entered).

In considering claim 13, Winbladh further discloses that the reply comprises an accept or

deny reply (i.e. correct confirmation is an accept reply, and incorrect confirmation is a deny

reply).

In considering claim 14, Lager further discloses the claimed ciphering step (col. 6, lines 10-20). It would have been obvious to include this in the system taught by Winbladh and Lager, in order to improve the security of the system.

In considering claim 15, Lager further discloses that the identification number associated with the mobile station is a MS-ISDN number (col. 3, lines 21-22).

In considering claim 16, Winbladh discloses a system at a mobile communication station ("MS unit 20" coupled to "PC 22") for facilitating immediate transfer of packet data from a network server ("server 11") to a mobile communication station over a digital radio communication network ("GSM" network), including:

First receiving means for receiving a message from a message service provided by the digital radio communication network, the message including a first data network address of said network server ("SMS [message] is sent to the MS unit 20, "col. 7, lines 6-8; wherein the "SMS message is comprised of... a field 'DSG address (Data SMS Gateway Address)' containing the address and/or telephone number of the server 11 in which the intended e-mail has been stored," col. 7, lines 7-8, 32-35);

Extracting means for extracting the fist data network address from the message (col. 7, lines 58-61, "the communications software 46 reads the agent-part 48 of SMS and... calls the number in the 'DSG address,'" wherein the "DSG" address is the address of the server, col. 7, lines 31-35); and

Packet data protocol means for establishing a data protocol session ("session") between said moble communication station and said network server using said first packet data network address (col. 7, lines 61-62, "calls the number in the 'DSG address' 47 (start of a session)"), and for receiving packet data from the network server addressed to a second packet data network address, which second packet data network address is allocated to the mobile communication station (col. 8, lines 53-61, wherein during the session, e-mails and other information are sent to the mobile station, which necessarily has a packet data network address since it is part of the packet data network).

However, Winbladh failed to specifically recite the digital radio communication network utilizes *packet*-based communication. Winbladh's uses a GSM network for communication that is not necessarily packet based ("GSM" network, col. 7, lines 3-8; col. 3, lines 50-52). Nonetheless, Winbladh disclosed that his system is not restricted to any specific wireless telephone system such as GSM and that other telecommunications systems can be used within the system (Col 3, lines 38-48). Thus, one of ordinary skill in the art would have been motivated to seek out and use other known wireless telephone systems within Winbladh's system. One widely known wireless telephone system that utilizes packet-based communication is GPRS. The use of GPRS in the wireless telephone environment was widely known in the art at the time of invention, as evidenced by at least by Lager and Applicant's admitted prior art (Specification pg 1). Further the inclusion of a GPRS system, including a GPRS attach within a GSM network was well known, as evidenced by Lager. In a similar art, Lager discloses a GSM system that allows a mobile device to set up a packet based session with a network service (Col 1, lines 17-22), including a means for allowing the mobile device to attach to the network, wherein the

system uses a GPRS attach (col. 3, lines 41-56; col. 7, line 64 – col. 8, line 30). Given this knowledge, a person having ordinary skill in the art would have readily recognized the desirability and advantages of incorporating the GPRS into the GSM system taught by Winbladh, because GPRS provides more effective use of scarce resources (see Lager, col. 1, lines 22-26). Therefore, it would have been obvious to incorporate the GPRS into the GSM system taught by Winbladh.

In considering claim 17, Winbladh further discloses that the message service is SMS ("SMS," col. 7, line 7).

In considering claim 18, Winbladh further discloses that the first packet data network address is an IP address (col. 7, lines 4-5, 61-62, wherein the server is an "Internet GSM Smart Access Server" and thus uses an IP address).

In considering claim 19, Winbladh further discloses means for identifying the mobile communication station to the packet data service part of the digital radio communication network, if the mobile communication station is not identified to that service (col. 8, lines 23-33, wherein upon start-up at the beginning of a session, the mobile station software sends its number and a password to the server).

In considering claim 24, claim 24 presents a program storage device for performing the same steps as the arrangement of claim 16, and is thus rejected for the same reasons.

In considering claim 25, Winbladh further discloses that the message service is SMS ("SMS," col. 7, line 7).

In considering claim 27, Winbladh further discloses that the first packet data network address is an IP address (col. 7, lines 4-5, 61-62, wherein the server is an "Internet GSM Smart Access Server" and thus uses an IP address).

In considering claim 28, Winbladh further discloses the program storage device performing the act of causing the mobile communication station to identify itself to the packet data service part of the digital radio communication network, if the mobile communication station is not identified to that service (col. 8, lines 23-33, wherein upon start-up at the beginning of a session, the mobile station software sends its number and a password to the server).

Response to Arguments

Applicant's arguments filed on January 5, 2005 have been fully considered but they are not persuasive. Applicant has argued the following:

a.   Winbladh does not teach using a packet based communication network for communication between the mobile device and server. Applicant also contends that the use of a packet based communication system within Winbladh system is unobvious. Examiner agrees with Applicant's argument insomuch that Winbladh discloses using a GSM communication

network, which is not natively packet based, for communication between the mobile device and

server. Nonetheless the contention by Applicant that it is unobvious to combine a packet based

communication system such as GPRS within the system of Winbladh is respectfully traversed.

Applicant attempts to argue that packet based communication systems were not known at the

time of Winbladh's filling and thus the inclusion of such a system within Winbladh's system

would be unobvious to one of ordinary skill in the art. Whether or not packet based

communication systems were known at the time of Winbladh's filling is irrelevant. The critical

date used for discerning the knowledge of one of ordinary skill in the art is Applicant's effective

filling date, which in the instant case is on 10/8/1999. The rationale set forth for the combination

of Winbladh and Lager is clearly outlined in the above action. It is again noted that Winbladh

clearly envisioned using other communication protocols and networks within his system as

recited in Col 3, lines 38-48. Further the use of packet based communication networks such as

GPRS in the wireless networking art was **extremely** well known at the time of Applicant's

invention as at least evidenced by Applicant's own admission (see Applicant's instant

specification pg 1) and the cited Lager reference.

Conclusion

15. The prior art made of record, in PTO-892 form, and not relied upon is considered pertinent

to applicant's disclosure.

16.   This office action is made **NON-FINAL.**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean Reilly whose telephone number is 571-272-4228. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

11/15/2005

KRISNA LIM
PRIMARY EXAMINER